

REMARKS

Claims 49-54 are all the claims pending in the application after entry of the forgoing amendments. Claims 1-48 and 55-72 are cancelled via this Amendment.

SPECIFICATION:

The Examiner objects to the specification as allegedly failing to provide proper antecedent basis for the claimed subject matter. In particular, the Examiner asserts that the recitation of the oil based ink being solid and hydrophobic at least at “one” temperature does not have proper antecedent basis in the specification. This objection is directed to claims 2, 4, 12, 18, 20, 34, 36, 55, 58, 61, 64, 67 and 70. Although Applicants respectfully do not fully agree with the objection, it is considered to be moot in view of the cancellation of the claims to which the objection is directed.

CLAIM OBJECTIONS:

Claims 7, 56, 59, 62, 65, 68 and 71

Claims 7, 56, 59, 62, 65, 68 and 71 are objected to because the Examiner alleges that the recitation of “plate cylinder mounted on the plate material” is not clear since it is the plate material that is mounted on the plate cylinder, not the other way around. Although Applicants respectfully do not fully agree with the objection, it is considered to be moot in view of the cancellation of the claims to which the objection is directed.

Claims 8, 57, 60, 63, 66, 69 and 72

Claims 8, 57, 60, 63, 66, 69 and 72 are objected to because the Examiner asserts that it is not clear how the subscanning is carried out by the head “approaching and separating” from the plate cylinder in an axial direction. Although Applicants respectfully do not fully agree with the objection, it is considered to be moot in view of the cancellation of the claims to which the objection is directed.

Claim 23

The Examiner asserts that the recitation of “a printing medium” in claim 23 is a double recitation because a “plate material” is recited in independent claim 19. This issue is deemed moot in view of the cancellation of claim 23.

Claims 35, 59, 62, 68 and 71

Claims 35, 59, 62, 68 and 71 are objected to because of formalities regarding an alleged double recitation in claim 35 of the image forming means, and antecedent basis issues in claims 59, 62, 68 and 71. This issue is deemed moot in view of the cancellation of claims 5, 59, 62, 68 and 71.

35 U.S.C. §112:

Claims 49-51

The Examiner asserts that the second and last paragraphs of claims 49-51 appear to be method steps and, thus, render the scope of the claims indefinite. Applicants respectfully traverse this rejection in view of the following remarks.

The use of functional language does not *per se* render a claim indefinite. Actually, as noted in MPEP §2114, “features of an apparatus may be recited either structurally or functionally.” Furthermore, MPEP §2173.05(g) points out that “there is nothing inherently wrong with defining some part of an invention in functional terms.” Moreover, claims 49-51 utilize means-plus-function language which requires the consideration of the claimed functional language.

Claims 52-54

The Examiner asserts that the recitation in the last paragraph of claims 52-54 does not clearly recite individual method steps of “stepping” the recording head. Claims 52-54 are amended to further define the language.

The Examiner points to the recitation of “repeatedly performing a step of roughly all channel widths so that no gap is produced.” The Examiner assumes that this recitation is referring to step B, as shown in Figure 11C. Applicants submit that the Examiner’s interpretation is substantially correct. In particular, the width of the channels is from the head position 56 - 1 to the head position 56 - 4, namely ten dots. However, the distance shown as “B”

is slightly more than ten dots, since this distance includes the two distances of “A.” Hence, the word “roughly” is used.

Applicants attach an Appendix “A” having a drawing to further aid in the Examiner’s understanding of the invention. The drawing illustrates an exemplary relationship between time and movement of the head. In light of the drawing and above-noted explanations, withdrawal of the rejection is respectfully requested.

35 U.S.C. §102:

Claims 33, 35, 37, 43 and 44 are rejected under 35 U.S.C. §102(a) as being anticipated by Okano et al. (WO 99/34982 [hereinafter “Okano”]). Without conceding to any of the Examiner’s assertions, Applicants respectfully submit that this rejection is deemed moot due to the cancellation of these claims.

35 U.S.C. §103 Kato/Okano:

- Claims 1-5, 7-10, 17-21, 23, 24, 27, 28, 33-37, 39, 40, 43 and 44 are rejected under 35 U.S.C. §103(a) as being unpatentable over Kato (JP 10-202,822) in view of Okano et al.
- Claims 6, 22, 25, 26, 38, 41 and 42 are rejected under 35 U.S.C. §103(a) as being unpatentable over Kato in view of Okano et al. as applied to the claims above, and further in view of Masaaki et al. (JP 58-147,373).
- Claims 11-13, 29-31 and 45-47 are rejected under 35 U.S.C. §103(a) as being unpatentable over Kato in view of Okano et al. as applied to claims 1-5, 7-10, 17-21, 23, 24, 27, 28, 33-37, 39, 40, 43 and 44 above, and further in view of Arway et al. (US 4,555,712).
- Claim 14 is rejected under 35 U.S.C. §103(a) as being unpatentable over Kato in view of Okano et al. as applied to claims 1-5, 7-10, 17-21, 23, 24, 27, 28, 33-37, 39, 40, 43 and 44 above, and further in view of Ikkatai (US 5,363,132).

- Claims 15, 32 and 48 are rejected under 35 U.S.C. §103(a) as being unpatentable over Kato in view of Okano et al. as applied to claims 1-5, 7-10, 17-21, 23, 24, 27, 28, 33-37, 39, 40, 43 and 44 above, and further in view of Totsugi (JP 02-95,86).
- Claim 16 is rejected under 35 U.S.C. §103(a) as being unpatentable over Kato in view of Okano et al. as applied to claims 1-5, 7-10, 17-21, 23, 24, 27, 28, 33-37, 39, 40, 43 and 44 above, and further in view of Gasparrini (US 5,322,015).

Without conceding to any of the Examiner's assertions, Applicants respectfully submit that the above-noted rejections are deemed moot due to the cancellation of the rejected claims.

- Claims 49-72 are rejected under 35 U.S.C. §103(a) as being unpatentable over Kato (JP 10-202,822) in view of Okano et al. and Kikuchi et al. (US 6,213,585). Applicants respectfully traverse the rejection in view of the following remarks. The rejection of claims 55-72 is deemed moot due to their cancellation. However, Applicants have not conceded to any assertions made by the Examiner regarding the rejected claims.

In regard to claims 49-54, Applicants submit that to establish a *prima facie* case of obviousness, the prior art references, when combined, must have taught or suggested all of the claimed features. (See MPEP §2143.) Applicants respectfully submit that the applied references would have failed to teach or suggest all of the claimed features.

In particular, one of the inventive and non-obvious features is the recited moving of the head. This claimed movement is not taught or suggested by Kato, Okano et al. or Kikuchi et al. Thus, their combination also fails to disclose the claimed features. As noted above, the claimed functional aspects are to be given weight in determining the patentability of the present claims. Moreover, Applicants respectfully submit that the ground of rejection supports the lack of teaching in the applied references by the absence of a clear indication as to where the claimed

features are allegedly found in the applied references. Accordingly, withdrawal of the rejection of claims 49-54 is respectfully requested.

35 U.S.C. §103(A) - Kato/ Vermot-Gaud:

- Claims 1-4, 7-9, 17-20, 23, 24, 27, 33-36, 40 and 43 are rejected under 35 U.S.C. §103(a) as being unpatentable over Kato (JP 10-202,822) in view of Vermot-Gaud et al. (US 5,001,496) and Cielo et al. (US 4,166,277).
- Claims 5, 21 and 37 are rejected under 35 U.S.C. §103(a) as being unpatentable over Kato in view of Vermot-Gaud and Cielo et al. as applied to the claims above, and further in view of Kojima et al. (JP 04-69,245).
- Claims 6, 22, 25, 26, 38, 41 and 42 are rejected under 35 U.S.C. §103(a) as being unpatentable over Kato in view of Vermot-Gaud et al. and Cielo et al. as applied to claims 1-4, 7-9, 17-20, 23, 24, 27, 33-36, 39, 40 and 43 above, and further in view of Masaaki et al. (JP 58,147-373).
- Claims 10-13, 28-31 and 44-47 are rejected under 35 U.S.C. §103(a) as being unpatentable over Kato in view to Vermot-Gaud et al. and Cielo et al. as applied to claims 1-4, 7-9, 17-20, 23, 24, 27, 33-36, 39, 40 and 43 above, and further in view of Arway et al. (US 4,555,712).
- Claim 14 is rejected under 35 U.S.C. §103(a) as being unpatentable over Kato in view of Vermot-Gaud et al. and Cielo et al. as applied to claims 1-4, 7-9, 17-20, 23, 24, 27, 33-36, 39, 40 and 43 above, and further in view of Ikkatai (US 5,363,132).
- Claims 15, 32 and 48 are rejected under 35 U.S.C. §103(a) as being unpatentable over Kato in view of Vermot-Gaud et al. and Cielo et al. as applied to claims 1-4, 7-9, 17-20, 23, 24, 27, 33-36, 39, 40 and 43 above, and further in view of Totsugi (JP 02-95,862).
- Claim 16 is rejected under 35 U.S.C. §103(a) as being unpatentable over Kato in view of Vermot-Gaud et al. and Cielo et al. as applied to claims 1-4, 7-9, 17-20, 23, 24, 27, 33-36, 39, 40 and 43 above, and further in view of Gasparrini (US 5,322,015).

Without conceding to any of the Examiner's assertions, Applicants respectfully submit that the above-noted rejections are deemed moot due to the cancellation of the rejected claims.

- Claims 49-72 are rejected under 35 U.S.C. §103(a) as being unpatentable over Kato (JP 10-202,822) in view of Vermot-Gaud et al., Cielo et al., and Kikuchi et al. Applicants respectfully traverse the rejection in view of the following remarks. The rejection of claims 55-72 is deemed moot due to their cancellation. However, Applicants have not conceded to any assertions made by the Examiner regarding the rejected claims.

Applicants respectfully submit that the applied references would have failed to teach or suggest all of the claimed features. Similar to above, one of the inventive and non-obvious features is the recited moving of the head. This claimed movement is not taught or suggested by Kato in view of Vermot-Gaud et al., Cielo et al., and Kikuchi et al. Thus, their combination also fails to disclose the claimed features. Again, the claimed functional aspects are to be given weight in determining the patentability of the present claims. Also, Applicants respectfully submit that the grounds of rejection support the lack of teaching in the applied references by the absence of a clear indication as to where the claimed features are allegedly found in the applied references. Accordingly, withdrawal of the rejection of claims 49-54 is respectfully requested.

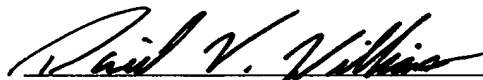
AMENDMENT UNDER 37 C.F.R. §1.111
U.S. Appln. No. 09/980,112

Art Unit 2854
Q67511

In view of the preceding amendments and remarks, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

A Petition for Extension of Time with appropriate fee accompanies this document. The USPTO is directed and authorized to charge all additional required fees (except the Issue Fee and/or the Publication Fee) to our Deposit Account No. 19-4880. Please also credit any over-payments to said Deposit Account.

Respectfully submitted,



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CUSTOMER NUMBER

Date: March 8, 2004